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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,693	09/28/2001	Kenji Watanabe	Q66444	2941

7590 05/14/2004
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EXAMINER

KRUER, KEVIN R

ART UNIT PAPER NUMBER

1773

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/964,693

Applicant(s)

WATANABE ET AL.

Examiner

Kevin R Kruer

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.Claim(s) objected to: NONE.Claim(s) rejected: 1,2,4 and 16-23.Claim(s) withdrawn from consideration: NONE.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Advisory Action

Applicant's arguments filed April 19, 2004 have been fully considered but are not persuasive. The proposed amendments filed April 19, 2004 will not be entered because they raise new issues that would require further search and/or consideration.

Specifically, Applicant has proposed narrowing the claims to specify the thickness of the claimed intermediate and base layers. Said limitation has not been previously considered and would require further search and/or consideration to determine whether said limitations would patentably distinguish the claimed invention from the prior art.

With regards to the outstanding rejections, Applicant argues that Example 9 provides support of the recitation of the absence of titanium in the intermediate layer in claim 17. Said limitation is also supported in the specification at page 75, lines 16-21 which states that the invention of Example 9 does not contain titanium compound. While the table shows that Example 9 contains no titanium dioxide, it does not have support for excluding all titanium oxides. Similarly, the disclosure at page 75 has support for the exclusion of titanium compound from the laminate, but does not have support for excluding titanium oxide only from the intermediate layer.

Applicant has proposed amendments to claims 22 and 23 (paragraphs (b), (c), and (d) in applicant's response) and argues that the proposed amendments overcome the outstanding 25 USC 112, first paragraph rejections. Since the proposed amendment has not been entered for the reasons specified above, Applicant's arguments are moot. Furthermore, Applicant's arguments with respect to the thickness

of the base and intermediate layers patentably distinguishing the claimed invention over the prior art are moot because the proposed amendment has not been entered.

With regard to the rejection of claims under 35 U.S.C. 103(a) as being obvious over JP'230 to Watanabe in view of Yoshizumi, Applicant argues that the proposed amendment limiting the thickness of the base layer and the intermediate layer overcomes the outstanding rejection. Since the proposed amendment has not been entered for the reasons specified above, Applicant's arguments are moot.

Furthermore, Applicant argues that the examiner's interpretation of JP'230 is erroneous because one skilled in the art would have understood that the base layer of JP'230 corresponds to the base layer of the present invention and the surface layer of JP '230 corresponds to the intermediate layer of the present invention. The examiner respectfully disagrees. The examiner's interpretation of the prior art represents the embodiment that most closely resembles the claimed embodiment. Specifically, the examiner's interpretation is representative of a laminate comprising the same layers in the same relative position and comprising the same composition as the claimed laminate. All the claim limitations have been met by the rejection. Thus, the rejection is maintained.

Applicant further argues that JP'230 teaches that surface layers with a chlorination degree of 58% or more are excluded. Therefore, one of skill in the art could not conceive an idea of using a PVC having a chlorination degree of from about 58-73% in the surface layer (the intermediate layer of the present invention)." However, the surface layer of JP 230 was not relied upon to read on the claimed intermediate layer.

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Rather, the base layer of JP'230 was relied up on to read on the claimed intermediate layer.

With regard to claim 19(1), Applicant argues that the antistatic layer functions as a surface layer and JP'230 teaches against the use of PVC having a chlorination degree of from 58-75% as a surface layer. The examiner disagrees with applicant's position that the antistatic layer is a surface layer and that one of ordinary skill in the art would have been bound by the surface layer teachings of JP'230 when selecting an antistatic layer. There is nothing in the reference that suggests such an interpretation. To the contrary, JP'230 clearly distinguishes between the surface layer and the antistatic layer. Thus, one of skill in the art would not have looked to the surface layer teachings of JP'230 to select the chlorination degree of the antistatic layer.

Furthermore, Applicant argues the teachings of paragraph 0015 of JP'230 refer to a description of properties of PVC for a flame-retardant molding, and not to the properties that should be employed in an antistatic layer. The examiner disagrees with Applicant's interpretation. Rather, the examiner believes that the teachings in paragraph 0015 are drawn to PVC compositions in general and maintains the position that said teachings would have provided motivation to one of ordinary skill in the art to optimize the chlorination degree of the antistatic layer.

With regard to JP'945 (referred to by applicant as JP'976), Applicant argues that JP'945 teaches that the surface layer should have a chlorination degree of 50% or less than 58%, and there is no reason to form a surface layer with a chlorination degree of 58-73%. The examiner respectfully disagrees with applicant's interpretation of the

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reference. JP'945 necessitates only that the surface layer should have a lower degree of chlorination than the substratum (paragraph 0040). Furthermore, the examiner notes that less than 58% (the end point of the range Applicant admits is taught by JP'945) and 58% (the claimed endpoint) are extremely close. The courts have held that a prima facie case of obviousness exists when the prior art range does not overlap the claimed range, but is close enough that one skilled in the art would have expected them to have the same properties (see MPEP 2141.05).

Applicant argues that there are "thickness related issues" involved in certain processing methods. However, the thickness of the layers comprising the currently claimed laminate is not limited. Thus, Applicant's argument is not persuasive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 571-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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